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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/582,232 | 07/24/2000 | JOHN ROGER SAMPSON | SAMP-US1 | 2557 |

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EXAMINER

LOPEZ, CARLOS N

ART UNIT

PAPER NUMBER

1731

DATE MAILED: 02/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/582,232

Examiner

Carlos Lopez

Applicant(s)

SAMPSON, JOHN ROGER

Art Unit

1731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 February 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 31-47 is/are pending in the application.
- 4a) Of the above claim(s) 40-47 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 31-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/10/03 has been entered.

Election/Restrictions

Newly submitted claims 40-47 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Restriction was required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 31-39, drawn to a smoking article.

Group II, claim(s) 40-43, drawn to method of producing a smoking article.

Group III, claim(s) 44-47, drawn to a hand rolling smoking kit.

The inventions listed as Groups I to III do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The common special technical feature of a smoking tobacco comprising shredded tobacco and reconstituted

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tobacco containing activated carbon which has a wrapper of 20 C.U or greater is shown to be obvious over Hedge (US 3,805,803) in view of Bowen et al (US 6,286,516). Hedge discloses a the claimed tobacco mixture as shown in example 2 but is silent disclosing the permeability of the wrapper. However, Bowen discloses that cigarette wrapper conventionally have a permeability of 5 to 50 C.U. Consequently, unity of invention is lacking among claims 31-47, as sharing a special technical feature that fails to contribute over the prior art.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 40-47 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 112

1) Claims 31-39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "increased perceived mildness" in claim 31 is a relative term which renders the claim indefinite. The term "increased perceived mildness" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The "perceived mildness" of a cigarette would vary from one smoker to another.

Claim Rejections - 35 USC § 103

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2) Claims 31 and 34-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hedge (US 3805803) in view of Hayden et al (US 5109876). Hedge discloses a tobacco rod comprising a blend of shredded tobacco and reconstituted tobacco (Example 2). The reconstituted tobacco is treated with activated carbon having a particle size less than 150 microns and may comprise up to 50% by weight (Column 1, lines 20ff). The reconstituted tobacco may be in the form of a sheet (Column 1, lines 57-62). Hedge is silent disclosing the claimed porosity of the tobacco rod wrapper. However, as taught by Hayden et al wrappers typically have an inherent porosity below 400 C.U (Column 3, lines 53-64). Hence, at the time the invention was made it would have been obvious to a person of ordinary skill in the art to wrap Hedge's tobacco rod with a conventional cigarette wrappers.

Additionally, in view that the cigarette resulting from teachings of Hedge and Hayden would meet the claimed structural limitations, a reduced sidestream smoke and increased perceived mildness by a smoker would be expected as recited in Applicant's claim 31.

As for claim 35, activated carbon particles would be expected to reduce aldehyde content of the mainstream smoke.

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3) Claims 32-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hedge (US 3805803) in view of Hayden et al (US 5109876) as applied to claim 31 above and in further view of Raker et al (US 5261425). Hedge and Hayden are silent disclosing sources of carbon. However, the claimed sources of carbon are well known in the art as disclosed by Raker (Column 12, lines 40ff). Hence, at the time the invention was made it would have been obvious to a person of ordinary skill in the art to use carbon particles with the cigarette resulting from the combination Hedge and Hayden with conventional sources of carbon particles as taught by Raker et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carlos Lopez whose telephone number is (703) 605-1174. The examiner can normally be reached on 8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on (703) 308-1164. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7718 for regular communications and (703) 305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.


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